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EXAMINER

ENGLAND, DAVID E

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/733,625
Filing Date: December 11, 2003
Appellant(s): BENNETT ET AL.

Marcia L. Doubet Reg. No. 40999
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/30/2009 appealing from the Office action mailed 07/31/2009.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Commonly-assigned and co-pending related application serial number 10/733985 was under appeal. A decision was rendered 01/26/2010 Affirming the Examiner using one of the same pieces of prior art used in the rejection on this application.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim states, "A computer program product for enabling users to subscribe to content in a computing environment, the computer program product comprising at least one computer usable storage medium having computer usable program code embodied therein," The specification defines the computer usable storage medium as, "including, but not limited to, disk storage, CD-ROM, optical storage, and so forth)," ¶0078. This open ended definition can leave to interpret that the computer usable storage medium could still be a transmission line and therefore is non- statutory. The Appellant is suggested to amend the claim to recite "non-transitory computer usable storage medium" to only claim hardware storage and not a transmission medium.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2004/0043758	Sorvari et al.	3-2004
6,731,393	Currans et al.	5-2004

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4 and 13 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Sorvari et al., (2004/0043758 hereinafter Sorvari) in view of Currans et al. (6731393

hereinafter Currans).

Referencing claims 1, 20 and 21, as closely interpreted by the Examiner, Sorvari teaches enabling users to subscribe to content in a computing environment, comprising:

identifying a content access behavior pattern of a user, (e.g., ¶ 0054, 0055, 0059 & 0167-0168);

responsive to the identifying, consulting a mapping to determine a candidate content subscription

to be offered to users exhibiting the identified behavior pattern, the candidate content subscription

indicating at least one portion of content generated by a content source, (e.g., ¶ 0061 – 0067,

0073-0078);

generating a markup language document representing the determined candidate content

subscription, (e.g., ¶ 0166 – 0173 & Figures 10 – 11H);

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offering, to the user, a subscription to the candidate content subscription using a graphical user interface constructed using the markup language document, (e.g., ¶ 0166 – 0173, 0179-0181 & Figures 9A – 11H);

responsive to acceptance of the offered subscription by the user, storing the markup language document as a trigger associated with the user and the content, (e.g., ¶ 0166 – 0173, 0179-0181 & Figures 9A – 11H); and

subsequently evaluating the content generated by the content source using the trigger, to determine whether any of the at least one portion of the content is considered a match to the trigger and if so, automatically sending each matching portion of the content to the user as the subscription, (e.g., ¶ 0011, 0062, 0086-0088, 0123.). Sorvari teaches the use of calendar information, (e.g., ¶ 0308), but does not specifically teach the subsequently evaluating further comprises scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger.

Currans teaches the subsequently evaluating further comprises scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger, (e.g., col. 12, line 58 – col. 13, line 52 & Figures 6 - 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Currans with Sorvari because utilizing a user calendar to have information sent to the user enables the user to dictate when they would receive information and not have information sent every time a match is made from the trigger. This would also lessen the amount of network traffic in the system.

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Referencing claim 3, as closely interpreted by the Examiner, Sorvari teaches enabling the user to customize the offered subscription from the graphical user interface prior to acceptance of the offered subscription, such that at least one condition is placed on at least one of the at least one portion of the content, (e.g., ¶ 0181 – 0186); and revising the markup language document to include each of the at least one condition prior to the storing, (e.g., ¶ 0181 – 0186).

Referencing claim 4, as closely interpreted by the Examiner, Sorvari teaches wherein the subsequently evaluated further comprises determining whether each of the at least one condition is considered a match to the trigger and only sending the matching portion of the content if so, (e.g., ¶ 0181 – 0186).

As per claim 13, as closely interpreted by the Examiner, Sorvari teaches the subsequently evaluated content comprises a then-current version of the content generated by the content source, (e.g., ¶ 0194 – 0197 et seq.).

As per claim 15, as closely interpreted by the Examiner, Sorvari teaches the subsequently evaluating is invoked responsive to occurrence of an event, (e.g., ¶ 0194 – 0197 et seq.).

As per claim 16, as closely interpreted by the Examiner, Sorvari teaches the identifying is performed by an inference engine, (e.g., ¶ 0091).

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As per claim 17, as closely interpreted by the Examiner, Sorvari teaches identifying comprises determining whether the user exhibits any of the plurality of predetermined content access behavior patterns, (e.g., ¶ 0061 – 0067, 0073-0078).

As per claim 18, as closely interpreted by the Examiner, Sorvari teaches the content is rendered on a web page and the identifying comprises identifying how the user interacts with the Web page, (e.g., ¶ 0190).

As per claim 19, as closely interpreted by the Examiner, Sorvari teaches the Web page lacks a subscription interface for enabling the user to subscribe to the rendered content, (e.g., ¶ 0055, Sorvari teaches displaying a normal web page that does not contain a type of subscription interface which if one were to take a subscription interface away from a web page then it would be a normal web page from a provider not altered by the invention.).

As closely interpreted by the Examiner, claim 14 is rejected for similar reasons as claim 6 since it can be interpreted that the calendar could be considered a timer of sorts and therefore the motivation also applies.

(10) Response to Argument

In the Arguments, Appellant argues in substance that Sorvari does not teach “responsive to the identifying, consulting a mapping to determine a candidate content subscription to be offered to users exhibiting the identified behavior pattern, the candidate content subscription indicating at

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least one portion of content generated by the content source”, emphases on the underlined sections.

As to this argument, if one were to look further into Sorvari one would see that the underlined sections are taught in paragraphs 0052, 0061 – 0067 and 0073 – 0078. As to the “consulting a mapping to determine a candidate content subscription to be offered to users exhibiting the identified behavior pattern”, the Appellant does not specifically define what the "mapping" is or what a subscription could or could not be. The Examiner considers the "mapping" to “content subscriptions” the same as a type of history data that links previously selected web sites to web sites a user might want to select or "subscribe to". In paragraph 0052 of Sorvari it is taught that a listing of network addresses previously selected by the user, hence history data of sites the user may like. Further into Sorvari it is taught that the user has a filtering criteria that is used to determine different services, i.e., web sites, that the user would be interested in, this is considered “mapping”, which is the determination of, or mapping, the specific sites that a user might like to the criteria. The sites are then displayed to the user which is considered the "candidate content subscription to be offered” which is due to the users exhibiting behavior patterns, i.e., the sites that they have seen and the other criteria that the user enters into their filter. This also is part of the interpretation of "indicating at least one portion of content generated by the content source" which is the URL being displayed to the user.

In the Arguments, Appellant argues in substance that Sorvari does not teach "generating a markup language document representing the determined candidate content subscription."

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As to this argument, it is clear to what is stated above that the URLs are displayed to the user in a Micro browser. But for further clarification, if the Appellant were to look at paragraph 0069 it is clear that XML tags are also user in making shortcuts to the services or web sites subscriptions, i.e., bookmarks to web sites, which is a markup language. Further teachings of the markup language are taught in paragraphs 0074 - 0078.

In the Arguments, Appellant argues in substance that Sorvari does not teach "storing the markup language document as a trigger associated with the user and the content".

As to this argument, Appellant's "trigger" is not specifically defined and therefore is up for interpretation as to what a "trigger" could be. The history data, criteria and user environment are used in the filter is interpreted as the "trigger". For one example, in paragraphs 0085 – 0088 the user's mobile device has sensors that are used to determine what the user's environment is and to infer a current context which bay be used to provide recommendations to the user based on those findings, i.e., are used as triggers once information is gathered and determined as to what is in the area and the user would like due to the previous content in the filter, ¶ 0087 – 0088. The shortcuts and other URLs are sent to the user in XML format and stored in the user's profile history, which are later used to aid in determining what a user would prefer to subscribe to. A user selecting the URL is "responsive to accepting the offered subscription". As further stated in ¶ 0088, "In one or more embodiments, the network server 826 may parse the op code and uses the device's past recommendations and context or past services used and context to find similar

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service recommendations in its database. The network server 826 then responds with information customized to the user's perceived interests, the information being related to the current context. While the above discusses one approach to recommending services, any user-related filter criteria may be employed to determine recommendations personal to the user." An example could be if a user wants to know where a store is located to they may visit it, they would select what they would like and since the selection is considered content access behavior patter, the server gives the user a recommendation, the user would select the recommendation, and the server would match what the user selected and sent information based on their behavior pattern and location, such as finding the nearest McDonalds.

In the Arguments, Appellant argues in substance that the prior art does not teach, “and scheduling time on an electronic calendar of the user when any of the at least one portion of the content is considered a match to the trigger”.

As to this argument, Currans teaches very similar triggers, i.e., profile and selection criteria used to filter and sent information, see figures 5 – 11, and calendar criteria that is used to send the user subscribed information, also see col. 7, lines 29 - 56, col. 8, col. 9, lines 27 – 67, col. 13, lines 11 – 51 and col. 14, lines 33 et seq. The Appellant argues that this is merely a schedule to print a newspaper at the user’s terminal. The Examiner agrees that this is one embodiment of the invention but it still reads on the claims that the information is sent on a time schedule, which could also be considered a trigger, of information the user wishes to view. Another embodiment Currans teaches that the user can select different formats to have the personalized document sent

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to them, col. 14, lines 45 – 50, “send the publication electronically via email...” Therefore it is clear that the user may receive a personalized document, i.e., personal newspaper, derived from user profile criteria, i.e., triggers, at a specific calendar time dictated by the user and sent to them in a format of their choosing. The reasoning that it would be obvious to add a calendar to schedule time to send personalized documents would be so the user does not have to constantly request information because the calendar would automatically send the accumulated information that user requested in their criteria filter for the user's personalized document when it is triggered at specific times.

All other arguments are similar to the ones discussed above and the teachings for such can be found in the cited areas above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of

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rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/David E. England/

Primary Examiner, Art Unit 2443

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Jack Harvey/

Director, Technology Center 2400

Conferees:

/George C Neurauter, Jr./

Primary Examiner, Art Unit 2443

/Tonia LM Dollinger/

Supervisory Patent Examiner, Art Unit 2443